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| EXAMINER |
|---|
| HUNTER, ALVIN A |

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/877,835
Filing Date: June 08, 2001
Appellant(s): NESBITT, R. DENNIS

Michelle Bugbee
The Top-Flite Company
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 27, 2004.

***(1) Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

***(2) Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

***(3) Status of Claims***

The statement of the status of the claims contained in the brief is correct.

***(4) Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on July 15, 2004 has been entered.

***(5) Summary of Invention***

The summary of invention contained in the brief is correct.

***(6) Issues***

The appellant's statement of the issues in the brief is correct.

***(7) Grouping of Claims***

The rejection of claims 1-9, 11-17, 19, and 20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

***(8) Claims Appealed***

***(8) Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

***(9) Prior Art of Record***

| | | |
|---|---|---|
| 5,779,562 | MELVIN et al. | 7-1998 |
| 5,688,595 | YAMAGISHI et al. | 11-1997 |

Farrally et al. "Double Cores" Science and Golf III, 1999, p.411

***(10) Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-9, 11-16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melvin et al. (USPN 5779562) in view of Yamagishi et al (USPN 5688595).

Melvin et al. discloses a multi-core, multi-cover golf ball having a core comprised of a center core layer and outer core layer and a cover comprised of an inner and outer cover layer (See Abstract). The center core layer and the outer core layer is made of polybutadiene and may also contain other types of materials such as a thermoset rubber or a thermoset elastomer material (See Column 5, lines 11 through 51). The polybutadiene comprises zinc diacrylate as the crosslinking agent (See Column 6, lines

1 through 11). The center core layer has a diameter of about 10 to 35mm, or .0394 to 1.378 inches, and the outer core layer has a diameter of about 30 to 40mm, or 1.181 to 1.575 inches (See Column 9, lines 20 through 28). The disclosure implicitly shows that the outer core layer has a thickness of about 2.5 to 10mm, or 0.098 to 0.394 inches. The outer core also has a Shore C hardness of less than 80, or less than about 53 Shore D. The inner and outer cover layers both comprise ionomer resin (Column 12, lines 41 through 47; and paragraph bridging Column 14 and 15). The inner cover layer is harder than the outer cover layer wherein the inner cover layer has a Shore D hardness of 60 or more and the outer cover layer has a Shore D hardness of 55 or less (See Column 12, lines 30 through 40; and paragraph bridging Column 14 and 15). Melvin et al. does not disclose having a center component softer than the core layer. Yamagishi et al. discloses a four piece golf ball having a dual core wherein the inner sphere is softer than the surrounding layer (See paragraph bridging Column 2 and 3 and Column 4, lines 21 through 32). The core construction allows for improved restitution and soft hitting feel. One having ordinary skill in the art would have found it obvious to have the inner sphere softer than the surrounding layer, as taught by Yamagishi et al., in order to improved restitution and hitting feel.

Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melvin et al. (USPN 5779562) in view of Yamagishi et al. (USPN 5688595) further in view of Farrally et al. (Science and Golf III).

Melvin et al. in view of Yamagishi et al. does not disclose the outer core layer having two or more layers. Farrally et al. discloses that having a core more than two

layers is advantageous for controlling the weight distribution of the golf ball (See Page 411). One having ordinary skill in the art at the time the invention was made would have found it obvious to incorporate a core layer with two or more layers in order to optimize the weight distribution and specific gravity of the golf ball.

***(11) Response to Argument***

In the appeal brief submitted by the appellant the following issues are at hand:

**A**. Not obvious to combine Yamagishi et al. with Melvin et al. due to the differences in cover layers and "obvious to try" rationale as motivation for the usage of the core;

**B**. Not obvious to combine Farrally et al. with Melvin et al. in view of Yamagishi et al. because Yamagishi et al. due to the deficiencies of Issue **A** and that Farrally et al. does not provide motivation.

In regards to issue **A**, in order to combine references, there must be teaching or suggestion for motivation, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, one must take in account what the prior art would implicitly teach, *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Melvin et al. teaches the above and implicitly teaches the core contributing to the restitution and feel of the golf ball. Yamagishi et al. teaches the use of a core having two layers in which the inner sphere is softer than the outer sphere in order to obtain improved resilience and hitting feel, which is clearly recited in the paragraph bridging columns 2 and 3 of the Yamagishi et al. reference. Appellant argues that the one having ordinary skill in the art would not be motivated to combine Yamagishi et al. with Melvin et al. because the cover

layers are different. The covers of Yamagishi et al., which the appellant argues as being an issue for combining with Melvin et al., is in fact not the issue at hand. The issue at hand is clearly geared toward the core layers of the golf ball. Yamagishi et al. is has clearly been applied for what it teaches of the core layers. Appellant further argues that the motivation for combining the core of Yamagishi et al. with the golf ball taught by Melvin et al. is "obvious to try" rationale. This is clearly not the case. Again, Yamagishi et al. provides a teaching as to why the inner sphere should be softer than the surrounding layer. It also should be noted that the applicant admits on the record on page 7 in the paragraph bridging from page 6 that the Melvin et al. teaches that the inner core can be either softer or harder than the core layer. Clearly, appellant admits that claims 1-3, 5-9, 11, 16, 19, and 20 are not patentable and are anticipated by Melvin et al. in alone in a 35 USC 102(b) setting.

In regards to issue **B**, Appellant argues that Farrally et al. clearly discloses that one would use a core with three layers in order to control the moment of inertia. This clearly appears be a motivation. In regards to the deficiencies of Yamagishi et al., see the above regarding Issue **A**.

It is believed by the examiner that the rejection above is proper and analogous because it teaches why one having ordinary skill in the art would be motivated to have a core with an inner sphere softer than the surrounding layer. For the above reason, it is believe that the rejection issued by the examiner should be sustained.

Respectfully submitted,

AAN

Alvin A. Hunter, Jr.
March 4, 2005

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